

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MADAN MOHAN R. APPIAH,  
TAD DENNIS BROCKWAY and RITU BAHL

Application 09/454,221

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on January 27, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the Image File Wrapper (IFW) indicates that the Final Rejection mailed January 13, 2004 is responsive to communication(s) filed on October 23, 2003. However, we are unable to locate papers filed on this date. Clarification or scanning in of the missing paper is required.

Appellants filed an Appeal Brief on August 15, 2005 using the format set forth in 37 CFR § 41.37(c). The Appeal Brief does not comply with 37 CFR § 41.37(c) because it is missing the following:

- (ix) Evidence appendix; and
- (x) Related proceedings appendix.

A supplemental brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark Office website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

An Examiner's Answer was mailed on November 16, 2005 in response to the Appeal Brief filed August 15, 2005. The Examiner's Answer does not comply with the headings as set forth in the new rules under 37 CFR § 41.37(c) because it is missing the "Evidence Relied Upon" section which lists the references being applied. See MPEP § 1207.02. Correction is required.

In addition, the grounds of rejection appearing in the Examiner's Answer and the Final Rejection do not agree. Specifically, the Final Rejection states:

1. Claims 1, 15, 26, 33 and 35 are rejected under 35 U.S.C. 112, second paragraph . . . [page 2];<sup>1</sup>
2. Claims 1, 15, 26, 33, and 35 are rejected under 35 U.S.C. 112, first paragraph . . . [page 3];
3. Claims 1, 2, 14-17, 26-28, 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Pager [sic, Poger] et al. with Patent Number 6,772,420 [page 3]; and
4. Claims 3-13, 18-25, 29-32, 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable by Pager [sic] et al. with Patent Number 6,772,420 over in view of Kathail et al. with Patent Number 5,802,365 {page 5}.

The grounds of rejection appearing in the Examiner's Answer are as follows:

1. Claims 1, 15, 26, 33 and 35 are rejected under 35 U.S.C. 112, first paragraph . . . [page 5]; and
2. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable by Poger et al. with Patent Number 6,772,420 over in view of Kathail et al. with Patent Number 5,802,365.

Clarification is required regarding the status of the § 102(e) rejection.

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<sup>1</sup> According to page 10 of the Examiner's Answer ((10) Response to Argument), "[t]he 112 enablement rejection should have been a 112 written description rejection . . . since there is no basis for an undue experimentation analysis, thus the enablement arguments are moot."

According to page 14 of the Examiner's Answer, [t]his examiner's answer contains a new ground of rejection set forth in section (9) above." In order to include a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in MPEP § 1207.03.

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section,  
and

Grounds of Rejection section.

The Examiner's Answer does not comply with the above requirements. To correct this problem, the examiner will need to vacate the Examiner's Answer mailed November 16, 2005. Once the Examiner's Answer mailed November 16, 2005 is vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;

- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

Finally, a Reply Brief was filed on January 17, 2006 in response to the Examiner's Answer mailed November 16, 2005. However, there is no indication in the record regarding whether or not the examiner has considered the Reply Brief.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to locate the papers filed on October 23, 2003 and have them scanned into the IFW, or clarify the correctness of the October 23, 2003 date;

2. to hold the Appeal Brief filed August 15, 2005 defective;

3. for notification to appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;

4. for consideration of the supplemental Appeal Brief;

5. to vacate the Examiner's Answer mailed November 16, 2005 and:

a. issue a revised Examiner's Answer in compliance with the new rules which became effective on

September 13, 2004 by including the "Evidence Relied Upon" section; and

b. select one of the following options:

(1) reopen prosecution;

(2) write a new Examiner's Answer without the new grounds of rejection; or

(3) write a new Examiner's Answer properly setting forth the new ground of rejection;

6. for consideration of and proper response to the Reply Brief filed January 17, 2006; and

7. for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
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